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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/840,451      | 04/24/2001  | Kuniaki Kawamura     | 199/49908           | 1890             |

23911 7590 11/18/2004  
CROWELL & MORING LLP  
INTELLECTUAL PROPERTY GROUP  
P.O. BOX 14300  
WASHINGTON, DC 20044-4300

EXAMINER

BORISSOV, IGOR N

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3629

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/840,451

Applicant(s)

KAWAMURA ET AL.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Examiner's Notes**

Upon reconsideration, the finality of the last Office Action has been withdrawn.

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

### ***Response to Amendment***

Amendment received on 11/01//2004 is acknowledged and entered. **Claim 1-12 and 14** have been canceled. **Claims 13 and 19** have been amended. **Claims 13 and 15-19** are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nierlich et al. (US 2003/0158632) (Nierlich) in view of Grinblat (US 4,902,322) and further in view of Houlihan (US 5,351,712).**

Nierlich teaches a method and system for monitoring and controlling energy distribution, comprising:

**Claims 13 and 19.** An energy management system comprising: means for monitoring energy consumed by the user (including HVAC units) over the Internet, wherein the user is notified about power curtailment events in accordance with the variation of the load, and wherein the power curtailment events include providing a listing of load reduction/displacement items including HVAC units, said load reduction

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/displacement is conducted when user load is reaching a predetermined projected level [0037]; [0066]; [0074]. Furthermore, Nierlich teaches: charging the user for the energy used, wherein charges reflect fluctuating (variations) power usage [0066].

Nierlich does not specifically teach that the power curtailment events include installing additional portable heating or cooling unit (hereafter referred to as unit) or reducing the number of existing units in accordance with the variation of the heat/cold heat load.

Grinblat teaches a method and system for supplemental air conditioning units for building, wherein a tenant who requires a lower temperature in his premises may install the supplemental unit (column 4, lines 64-68). However, Grinblat does not specifically teach that said unit is a portable unit.

Houlihan teach a hot water recovery method and apparatus, wherein said apparatus may be implemented as a portable unit, and may be temporarily installed by lessees or leased structures who desire reduce utility costs by saving energy consumption (column 14, lines 7-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nierlich to include that the power curtailment events include installing additional heating or cooling units, as disclosed in Grinblat, because it would advantageously allow to solve the local environmental needs of individual tenants without costly renovating of whole building heating system, thereby saving funds. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nierlich in view of Grinblat to include that said unit is a portable unit, as disclosed in Houlihan, because it would advantageously simplify the installation processes of this unit, therefore decrease costs associated with it.

**Claim 15.** Nierlich teaches said method and system, in which the user is charged for the energy used and wherein charges reflect fluctuating power usage [0066].

**Claims 16 and 17.** Same reasoning as in claim 13.

**Claim 18.** Nierlich et al. teach said method and system, comprising providing a network (the Internet) and servers for circuitry monitoring, and monitoring data related to the amount of power used in order to effect power curtailment events, wherein said data is shared over the Internet [0037]; [0046]; [0049]; [0085].

### ***Response to Arguments***

Applicant's arguments filed 11/01/2004 have been fully considered but they are not persuasive.

In response to the applicant's argument that claim 13 is allowable because it includes limitations of the canceled claim 14, it is noted that the specific feature, upon which the Applicant relies in claim 13, is disclosed in Nierlich. Specifically, Nierlich teaches: charging the user for the energy used, wherein charges reflect fluctuating (variations) power usage [0066].

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
Washington D.C. 20231***

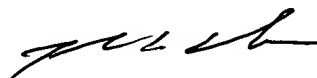
or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB

8/28/2004



**JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**